

REMARKS:

In the Office Action the Examiner noted that claims 1, 2, 4-8, 10-14, and 16-18 are pending in the application. Claims 1, 2, 7, 8, 13 and 14 are amended herein. No new matter is presented. Thus, claims 1, 2, 4-8, 10-14, and 16-18 are pending and under consideration. The rejections are traversed below.

REJECTIONS UNDER 35 USC § 112:

Starting on page 2 of the Office Action the Examiner rejected claims 1, 2, 7, 8 and 12-14 under 35 U.S.C. §112.

The Examiner alleged that the Specification does not provide support for the claimed feature directed to not extracting any mail address contained in the text of the e-mail received when the reply destination mail address is not the address of the mailing list.

Support for this feature of the invention can be found at least on Page 4, lines 5-11; page 16, lines 1-10; page 18, lines 14-19, and Figs. 3-5 of the Specification as filed. For example, as illustrated in Fig. 5 of the present application, operation S504 judges whether a mail address of a reply is registered in the mailing list, and if so, extracts mail addresses contained in the mail text (S505). Meaning, the mail address that is not registered in the mailing list is not extracted as illustrated in operation S505 of Fig. 5.

Therefore, withdrawal of the rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1, 2, 4-8, 10-14 and 16-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,938,725 (Hara) in view of U.S. Patent No. 6,785,710 (Kikinis).

Hara does not teach or suggest "a judging unit which judges whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list used for broadcasting the same E-mail to a plurality of destinations at one time by a predetermined single mail address by comparing with addresses registered in a mail address book", as recited in claim 1.

Hara does not teach or suggest judging or determining whether an e-mail address part of a mailing list used for broadcasting an e-mail to a plurality of destinations using a single mail address for purposes of transmitting a reply. That is, Hara merely mentions global address

communication function, and does not enable the claimed judging "whether or not a reply destination mail address extracted from an E-mail received is an address of a mailing list [and] comparing with addresses registered in a mail address book", as recited in claim 1 (see also, claims 7 and 13 reciting similar features).

Independent claims 2, 8 and 14 also recite "a first extracting unit which automatically extracts a reply destination mail address from a mail header of an E-mail received" and "a second extracting unit which automatically extracts at least one mail address of a mailing list contained in a text of the E-mail received by comparing with addresses registered in a mail address book." The invention of claims 2, 8 and 14 also judges whether the reply destination mail address is "an address of the mailing list."

Hara does not teach or suggest displaying "the at least one extracted mail address as a candidate for a reply destination from which a specified reply destination is selected", where the specified reply destination is used for transmitting "a reply in response to the E-mail received", as recited in claims 1, 7 and 13.

Claims 2, 8 and 14 recite displaying "all the extracted mail addresses as candidates for reply destinations from which a specified reply destination is selected, said specified reply destination being used for transmitting a reply in response to the E-mail received."

Instead, in Hara the transmission destination address is determined based on a keyword. Retrieval of the mail address in Hara is carried out by checking as to whether or not a keyword is present in the title and the communication message, and the mail address contained in the retrieved electronic mail message is extracted, and then is outputted as the mail address of the transmission destination candidate to the output means (see, col. 3, lines 11-18).

As discussed above, the independent claims patentably distinguish over Hara. Further, as Kikinis merely discloses manually inserting a reply address, Kikinis does not cure the deficiencies of Hara regarding the independent claims of the present application.

Kikinis is directed to the functionality of e-mail clients to manually choose and insert a correct "from" or "reply to" addresses in the agent's e-mail reply to the original e-mail sent by the customer. As explicitly stated at col. 5, lines 49-67 of Kikinis, "...for the situation of a multi-tenant call center wherein agents may represent and answer e-mails for multiple companies... it is necessary that an agent be capable of at least manually entering, in a reply to a received e-

mail, a "from" and "reply-to" address for the company to which an e-mail he or she answers was originally sent."

The Examiner refers to col. 6, lines 1-14 of Kikinis as teaching "extracting", as taught by the claimed invention. However, this portion of Kikinis merely discusses selection of "send-to" address from a lookup table (33) using a special code or an order number identified in the e-mail with the correct company name, e-mail addresses and product-order numbers (see also, Fig. 2 including corresponding text).

As can be seen from the above discussion, Kikinis does not teach or suggest "an extracting unit which automatically extracts at least one mail address of the mailing list contained in a text of the E-mail received when the reply destination mail address is judged to be the address of the mailing list, and does not extract the at least one mail address when the reply destination mail address is judged to not be the address of the mailing list", as for example recited in claim 1 (see also above discussion of other independent claims).

For the above-discussed reason, the Examiner does not appear to have established a prima facie case of obviousness. For this reason it is requested that the rejection be withdrawn.

Even assuming arguendo that Kikinis does disclose the features discussed by the Examiner, the Applicants respectfully submit that there is no apparent motivation to combine the cited references. The Examiner stated that the combination of the references would be obvious because the teaching of Kikinis on parsing the body of the message would provide automatically choosing and inserting address in the appropriate field box of an e-mail reply to an original message.

Applicants respectfully traverse the obviousness rejection based on Kikinis and Hara because there is insufficient evidence for a motivation to modify the Hara system extracts mail addresses from matching stored e-mail messages containing a keyword using manual insertion of reply to addresses by incorporating Kikinis.

MPEP §2143.01 states that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. Therefore, as there is no requisite motivation to combine the references cited by the Examiner, the Applicants respectfully request the withdrawal of the Examiner's §103 rejections.

For at least the above-mentioned reasons, claims depending from the independent claims are patentably distinguishable over the cited references. The dependent claims are also independently patentable.

For example, as recited in claim 6, the claimed invention includes displaying "when visibly displaying all the extracted mail addresses as the reply destination candidates, the name of the mail address extracted from the text of the received E-mail and unregistered in the mail address book as the name unknown in the format of corresponding to the mail address." Kikinis and Hara, alone or in combination, do not teach or suggest these features of claim 6.

Therefore, withdrawal of the rejection is respectfully requested.

CONCLUSION:

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.


Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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